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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/072,471

Applicant(s)

HUNTER ET AL.

Examiner

ANNAN Q. SHANG

Art Unit

2623

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-14 and 18-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-14 and 18-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/23/08 have been fully considered but they are not persuasive.

With respect to the rejection of the last office action mailed on 01/25/08, Applicant recites the claims limitations and the prior arts of record, and further argues that the prior arts of record do not teach the claims limitations (see page 8 of 16+ of Applicant Remarks).

In response, Examiner disagrees. Examiner notes Applicants arguments, i.e., that "...Dimitri does not teach recitations of claim 18..." that, "...a second medium, distinct from the first medium..." The recited claims limitations do not require the different mediums to store advertisements (ads) and movies. Dimitri discloses "...a reader mechanism having a single optical pickup and configured to read entertainment content pre-recorded..." (see abstract, figs.1B+, col.3, line 43-col.4, line 1+ and col.5, line 22-col.6, line 1+). Hence the rejection is proper, meets all the claim limitations of claims 18-20, maintained as repeated below.

With respect to the 103(a) rejection of claims 1, 5-9, 11, 22-27, 30, 31, 34, 35, and 48 as being unpatentable over Lowther in view of Sartain, Applicant further states that "...the cited references,...do not teach the recitations of claim 1..." i.e., that "...periodically distributing advertisements per..." In response to Applicant's arguments, Lowther teaches a distributor which employs "**sneakernet**" a process where ads, content, info segment, etc., stored on CD-ROM, DVD, etc., are distributed via

convention mail (physical or hand delivery) to various locations (figs.1+ and page 1, [0024]) and one skill in the art knows that these distribution method is usual done periodically (monthly). Although, Lowthert sneakernet system does not distribute the same ads or other various content, but rather updates or new content, Lowthert is silent as to periodic distribution. However, in the same field of endeavor **Sartain** reference figures 1-7, discloses an interactive video system which periodically (once a day, once a week, etc.,) distributes ads and other content via overnight mail to remote sites (col.1, line 56-col.2, line 13, col.5, lines 23-43, col.8, line 29-46, col.9, line 60-col.10, line 26 and line 53-col.11, line 1+). Lowthert further disclose various payment options (e.g., "...a fee may be automatically charged to the user's predetermined account.") for the distribution or transmitting of content ([0034]), which meets the limitations "...communicating information that is representative of the playing of entertainment content and advertisements between the customer and a system operator.

Applicant further argues of limitation "...an optical reader operating at a wavelength at or below 405nm." that "...Sandstrom describe thickness of various recording and dielectric layers, but not disclose...wavelengths..." claims 38 and claims 12-13 (page 12 of 16+).

In response, Examiner disagrees. Lowthert teaches using standard various storage mediums (videotape, digital videotape, hard disk, CD-R, CD-RW, DVD-R, semiconductor, or any other suitable storage mechanism(s), but silent to the specification of the medium(s), "...a disc having a diameter greater than about 125mm and less than 300mm and where the first medium comprises a disc having data

recorded on a reflective layer and an optically transmissive coating having a total transmission of 635nm or less than the minimum transmission set forth as the standard DVD specification..." as recited in the claims. However, an analogous field endeavor, **Sandstrom** discloses in figures 1-2, rewritable optical data storage disk having enhanced flatness and discloses a disc having a diameter greater than about 120mm and less than 135mm and various substrate thickness and wavelength (col.1, lines 24-44, col.2, lines 24-46, col.3, line 66-col.4, line 31, col.8, line 32-col.9, line 30). Furthermore, it has been held that where the general conditions of are disclosed in the prior art, except for size, it would have been obvious matter of design choice, since such modification would have involved a mere change in the size of a component, and change in size is generally recognized as being within the level of ordinary skill in the art. ***In re Rose*, 105 USPQ 237 (CCPA 1995)**. Additionally, it has been held that where the general conditions of a claim are disclosed in the prior art, except for an optimum value, it would have been obvious to one having ordinary skill in the art at the time of the invention to reach such an optimum value, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. ***In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)**.

As to claims the 103(a) rejection of 2-4, 14, 36 and 37, for the reasons discussed above, Examiner maintains the rejection is proper, meets all the claim limitations and maintained.

As to the 103(a) rejection of claims 28-29, over Lowther in view of Sartain and further in view of Ginter, Applicant further argues as to "...shipping entertainment

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content...on a periodic basis..." and disagrees with the rejections. In response to Applicant's remarks, one skill in the art knows that most conventional mail distribution method is usually done periodically (monthly). Although, Lowthert sneakernet system is silent as to periodic distribution even though is clear from the disclosure that different or new ads and new content "updates" are distributed in some order to the clients. Lowthert as modified by Sartain, teach periodic distribution of content and targeting to customer preferences, but silent as to shipping entertainment content. However, **Ginter** disclose periodic shipping entertainment content on a periodic basis and further teaches targeting content to customer, based on preferences ([0201-0203], [1049] and [1178-1182]). Hence Applicant's arguments are not persuasive. The rejection is proper, meets all the claims limitations as discussed below. **This office action is made final.**

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Dimitri et al (6,574,424)**.

As to claim 18, note the **Dimitri** reference figures 1-5, discloses method and apparatus for a randomizer for DVD video and further discloses a player device configured to generate audio visual signals representative of entertainment with advertisements, the device comprising:

A Reader mechanism having a single optical pickup and configured to read entertainment content prerecorded on a first medium and to read advertisements pre-recorded on a second medium (figs.1-5, col.3, lines 43-col.4, line 17); and a processor configured to generate command signals inserting advertisements read by the reader mechanism from the second medium into entertainment content read by the reader mechanism from the first medium (col.4, line 27-col.5, line 41 and line 51-col.6, line 67).

As to claim 19, Dimitri further discloses where the player device comprises a reader mechanism includes a single optical pickup and where the first and second media are mechanically, sequentially moved for reading (col.3, lines 43-col.4, line 17 and line 27-col.5, line 41).

As to claim 20, Dimitri further discloses where the player device further comprises a memory device configured to store read data to permit seamless, uninterrupted insertion of advertisements into entertainment content (col.4, lines 4-36 and col.5, line 16-col.6, line 1+)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5-9, 11, 22-27, 30, 31, 34, 35 and 38 are rejected under 35

U.S.C. 103(a) as being unpatentable over **Lowthert et al (2002/0100043)** in view of **Sartain et al (5,914,712)**.

As to claim 1, note the **Lowthert** reference figures 1-5, discloses content with advertisement information segment and further discloses a method of providing a consumer with entertainment content coupled with updated advertisements, comprising:

Distributing entertainment content pre-recorded on entertainment content storage media to the customer locations, the entertainment content media including insertion points for advertisements; and periodically distributing advertisements pre-recorded on advertisement storage media to the customer locations, where at least some of the advertisements are updated before being distributed (R-10, page 1, [0024-0030] and [0048-0049]);

Where the player devices are configured such that, when a customer inserts an entertainment content medium and an advertisement medium into the player device at the customer's location, the player device displays selected entertainment pre-recorded on the advertisement medium, where the advertisements are displayed at the insertion points (page 2, [0032-0033], [0038], [0043] and [0047]); note the links to R-10 includes CD-ROM, DVD, DVD-R/RW, hard drive, removable hard drive, etc., which are physically insert at the customer location.

Lowthert updates some of previously stored or pre-recorded ads and other content and distributes ads and other content upon request. Lowthert teaches a distributor which employs "**sneakernet**" a process where ads, content, info segment, etc., stored on CD-ROM, DVD, etc., is distributed via convention mail (physically carried) to various locations (figs.1+ and page 1, [0024]) and one skill in the art knows that these distribution method, e.g., conventional mail, etc., is usually done periodically (monthly). Although, Lowthert sneakernet system does not distribute the same ads or same content to the clients, but rather updates or new content, Lowthert is silent as to periodic distribution.

However, in the same field of endeavor **Sartain** reference figures 1-7, discloses an interactive video system which periodically (once a day, once a week, etc.,) distributes ads and other content via overnight mail to remote sites (col.1, line 56-col.2, line 13, col.5, lines 23-43, col.8, line 29-46, col.9, line 60-col.10, line 26 and line 53-col.11, line 1+).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Sartain into the system of Lowthert to periodically distribute pre-recorded content to remote areas to enable users to update the outdated ads or other content with new ones.

As to claim 5, Lowthert further disclose where each of the ads media includes ads an index of entertainment content (page 2, [0032-0036] and [0039-0040]).

As to claims 6-7, Lowthert further disclose where the advertisements include current movie previews and where the player devices are further configured to display

the movie previews before displaying the selected entertainment content displays selected (page 3, [0036] and [0047-0049]).

As to claims 8-9, Lowthert further where the advertisements include commercial advertisements other than movie previews, where the player devices are configured to display the commercial advertisements other than movie previews before displaying the selected entertainment content (page. 3, [0036] and [0047-0049]).

As to claim 11, Lowthert further teaches generating customer preferences by analysis of customer characteristics and where the player devices are further configured to select a subset of the advertisements contained in the advertisement medium based upon customer preference (page 2, [0035-0036] and [0043-0048]).

As to claim 22, the claimed "A method of providing consumers with entertainment content coupled with updated advertisements..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claim 23 is met as previously discussed with respect to claim 5.

As to claim 24, Lowthert further discloses distributing the items to the customers free of charge (page 1, [0019-0024]).

As to claim 25, Lowthert further discloses where distributing items to customers is at a charge to customers not exceeding production and shipping costs (page 2, [0034-0036] and [0047-0049]).

As to claims 26-27, Lowthert further discloses where the customers are provided with the entertainment content and updated advertisements without the necessity of the customers having cable TV or direct broadcast satellite service and inputting display

signals from a broadcast source into the player device and inserting advertisements pre-recorded on the second medium into the broadcast content (page 1, [0020-0025], [0032-0036] and [0042-0047]).

Claims 30-31 are met as previously discussed with respect to claim 1.

As to claim 34, Lowthert further discloses charging customers for playing entertainment content on a one time fee-to-own basis (page 3, [0063]).

As to claim 35, Lowthert further discloses where communicating information that is representative of the playing of entertainment content and advertisements between the customer and system operator (page 2, [0032-oo36] and [0042-0047]).

Claim 38 is met as previously discussed with respect to claims 12-13.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Dimitri et al (6,574,424)** as applied to claim 18 above, and in view of **Lowthert et al (2002/0100043)**.

As to claim 21, Dimitri is silent as to where the player device includes an input for displaying signals from a broadcast content source and inserting advertisements prerecorded on the second medium into the broadcast content.

However, Lowthert discloses a player device with an input (PD-14) for displaying signals from a broadcast content source and inserting advertisements prerecorded on the second medium into the broadcast content (page, [0019] and [0043-0049]).

Hence it would have been obvious to one of ordinary skill in the art at the time of the invention in incorporate the teaching of Lowthert into the system of Dimitri to enable the player device to receive signals from other input source(s).

7. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lowthert et al (2002/0100043)** in view of **Sartain et al (5,914,712)** as discussed above with respect to claim 1, and further in view of **Sandstrom (6,238,763)**.

As to claims 12-13 Lowthert further discloses where the first medium comprises a disc having a diameter greater than about 125mm and less than 300mm and where the first medium comprises a disc having data recorded on a reflective layer and an optically transmissive coating having a total transmission of 635nm or less than the minimum transmission set forth as the standard DVD specification (page 2, [0021-0025] and ([0048-0049])).

However, an analogous field endeavor, **Sandstrom** discloses in figures 1-2, rewritable optical data storage disk having enhanced flatness and discloses a disc having a diameter greater than about 120mm and less than 135mm and various substrate thickness and wavelength (col.1, lines 24-44, col.2, lines 24-46, col.3, line 66- col.4, line 31, col.8, line 32-col.9, line 30). Furthermore, it has been held that where the general conditions of are disclosed in the prior art, except for size, it would have been obvious matter of design choice, since such modification would have involved a mere change in the size of a component, and change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1995). Additionally, it has been held that where the general conditions of a claim are disclosed in the prior art, except for an optimum value, it would have been obvious to one having ordinary skill in the art at the time of the invention to reach such an optimum value,

since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Therefore it would have been obvious at the time of the invention to modify Lowthert and Sandstrom to construct a disk with additional coating material to enhance recording and provide a desire diameter to meet specification of specific devices.

8. Claims 2-4, 14, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lowthert et al (2002/0100043)** in view of **Sartain et al (5,914,712)** as applied to claim 1 above, and further in view of **Shear et al (2001/0042043)**.

As to claims 2-3, Lowthert as modified by Sartain, fail to explicitly teach disclose storage medias with hardware security feature where display is possible if the hardware is compatible with the hardware security feature.

However, note the **Shear** reference figures 1-3 and 12-14, discloses storage media electronic rights management in closed and connected appliances which employs hardware security feature and software to permit access to stored or recorded content on stored media (page 6, [0071-0072], [0162-0163], [0212-0213], [0280] and [0319+]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Shear into the system of Lowthert as modified by Sartain to protect content on portable storage media and manage rights to information stored on the portable storage media

Claim 4 is met as previously discussed with respect to claim 1.

As to claim 14, Lowthert as modified by Sartain, fail to explicitly teach where the player devices are configured to permit downloading content from the player device to a second portable player device.

However, **Shear** further discloses a method and system that permits player devices to download content from other portable player device ([0054-0055], [0061-0068], [0162-0163], [0212-0213], [0280] and [0319+]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Shear into the system of Lowthert as modified by Sartain to allow other users with portable storage media to share stored content on a master device after meeting certain conditions.

As to claim 36, Lowthert as modified by Sartain teaches all the claim limitation as previously discussed with respect to claim 22 above, but fail to teach "...downloading content..." however, this is met as previously discussed with respect to claim 14.

As to claim 37, Lowthert further teach where the player device includes a projector ([0049])

9. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lowthert et al (2002/0100043)** in view of **Sartain et al (5,914,712)** as applied to claim 22 above, and further in view of **Ginter et al (2004/0054630)**.

As to claims 28-29, Even though, one skill in the art knows that most conventional mail distribution method is usually done periodically (monthly), Lowthert

sneakernet system is silent as to periodic distribution even though is clear from the disclosure that different or new ads and new content "updates" are distributed in some order to the clients. Lowthert as modified by Sartain, teach periodic distribution of content and targeting content to customer, base on preferences, but silent as to shipping entertainment content.

However, **Ginter** disclose periodic shipping entertainment content on a periodic basis and further teaches targeting content to customer, based on preferences ([0201-0203], [1049] and [1178-1182]).

However, **Ginter** disclose periodic shipping entertainment content on a periodic basis and further teaches periodic shipments base on customer preferences ([0201-0203], [1049] and [1178-1182])

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Ginter into the system of Lowthert as modified by Sartain to physically delivery up to date target content to customers irrespective of their location(s)

10. Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lowthert et al (2002/0100043)** in view of **Sartain et al (5,914,712)**as applied to claim 22 above, and further in view of **Russo (6,732,366)**.

As to claims 32 and 33, Lowthert as modified by Sartain, disclose encrypting content and charging fee for playing the content, but silent to various fee payment methods, such as PPV basis and subscription basis.

However, **Russo** disclose a pay-per-play system that provides various paying method to enable a user to select a desired payment method, such as PPV basis and subscription basis (col.4, line 39-col.5, line 2 and col.6, line 46-col.7, line 35).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Russo into the system of Lowthert as modified by Sartain to enable the user to select an affordable payment method.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA)** or **571-272-1000**.

/Annan Q Shang/

Primary Examiner, Art Unit 2623

Annan Q. Shnag